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EXAMINER

SMITH, PETER J

ART UNIT	PAPER NUMBER
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2176

DATE MAILED: 09/28/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/579,256	KHATWANI ET AL.	
	Examiner	Art Unit	
	Peter J Smith	2176	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 June 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7,9-17,19-25,27-37 and 39-70 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7,9-17,19-25,27-37 and 39-70 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) * | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>3/15/04</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This action is responsive to communications: amendment filed on 6/4/2004, IDS filed on 3/15/2004.
2. Claims 1-7, 9-17, 19-25, 27-37, and 39-70 are pending in the case. Claims 1, 13, 32, 47, 48, 53, 60, 64, 65, 66, 67, 68, 69, and 70 are independent claims.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. **Claims 1-4, 9-12, 48-50, and 65 are rejected under 35 U.S.C. 103(a) as being unpatentable over *Page Frame Feature for Printing Electronic Documents*; International Business Machines Research Disclosure (hereinafter “ IBM Research Disclosure”); May 1999, pages 688-690 in view of Tsimelzon, US 6,763,388 B1 filed 8/10/1999.**

Regarding independent claim 1, IBM Research Disclosure teaches receiving a first web document including formatting information used to display the first web document in page 688. IBM Research Disclosure teaches receiving a request to obtain a selected portion of the document in fig. 4 and pages 689-690. IBM Research Disclosure teaches a print preview feature in page 688 which generates another representation of the document from the selected portion.

IBM research disclosure does not teach creating a second web document including the selected portion and the formatting information associated with the selected portion, in response

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to receiving a request, wherein the first web document and second web document are markup language documents. Tsimelzon does teach creating a second web document including the selected portion and the formatting information associated with the selected portion, in response to receiving a request, wherein the first web document and second web document are markup language documents in fig. 3-4, col. 5 lines 15-16, and col. 5 line 37 – col. 6 line 15.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined Tsimelzon into IBM Research Disclosure to have created the claimed invention. It would have been obvious and desirable to have used the teaching of Tsimelzon to have enhanced the print preview of IBM Research Disclosure so that the preview could have been editable by the user without affecting the original web page.

Regarding dependent claims 2-4, IBM Research Disclosure teaches the use of both a web browser display device and a printer for outputting a web page document in page 688.

Regarding dependent claim 9, IBM Research Disclosure teaches the use of markup language documents on page 688. It was well known at the time of the invention that markup language documents contained formatting information in a series of tags. Tsimelzon further shows HTML formatting information in a series of tags in fig. 3.

Regarding dependent claim 10, IBM Research Disclosure teaches the use of markup language documents to form web pages in page 688. It was well known at the time of the invention that hypertext markup language was the most commonly used markup language used to form web pages.

Regarding dependent claim 11, IBM Research Disclosure teaches the use of markup language documents to form web pages in page 688. It was well known at the time of the

invention that hypertext markup language was the most commonly used markup language used to form web pages. It was well known at the time of the invention that hypertext markup language contained formatting information in a series of tags.

Regarding dependent claim 12, IBM Research Disclosure teaches the use of a header in page 688 and fig. 1.

Regarding independent claim 48, IBM Research Disclosure teaches receiving a first web document including formatting information used to display the first web document in page 688. IBM Research Disclosure teaches receiving a request to obtain a selected portion of the document in fig. 4 and pages 689-690. IBM Research Disclosure teaches a print preview feature in page 688 which generates another representation of the document from the selected portion.

IBM research disclosure does not teach creating a second web document including the selected portion and the formatting information associated with the selected portion, in response to receiving a request, wherein the first web document and second web document are markup language documents. Tsimelzon does teach creating a second web document including the selected portion and the formatting information associated with the selected portion, in response to receiving a request, wherein the first web document and second web document are markup language documents in fig. 3-4, col. 5 lines 15-16, and col. 5 line 37 – col. 6 line 15.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined Tsimelzon into IBM Research Disclosure to have created the claimed invention. It would have been obvious and desirable to have used the teaching of Tsimelzon to have enhanced the print preview of IBM Research Disclosure so that the preview could have been editable by the user without affecting the original web page.

Regarding dependent claims 49-50, IBM Research Disclosure teaches the use of both a web browser display device and a printer for outputting a web page document in page 688.

Regarding independent claim 65, IBM Research Disclosure teaches receiving a first web document including formatting information used to display the first web document in page 688. IBM Research Disclosure teaches receiving a request to obtain a selected portion of the document in fig. 4 and pages 689-690. IBM Research Disclosure teaches a print preview feature in page 688 which generates another representation of the document from the selected portion.

IBM research disclosure does not teach creating a second web document including the selected portion and the formatting information associated with the selected portion, in response to receiving a request, wherein the first web document and second web document are markup language documents. Tsimelzon does teach creating a second web document including the selected portion and the formatting information associated with the selected portion, in response to receiving a request, wherein the first web document and second web document are markup language documents in fig. 3-4, col. 5 lines 15-16, and col. 5 line 37 – col. 6 line 15.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined Tsimelzon into IBM Research Disclosure to have created the claimed invention. It would have been obvious and desirable to have used the teaching of Tsimelzon to have enhanced the print preview of IBM Research Disclosure so that the preview could have been editable by the user without affecting the original web page.

5. Claims 5, 13-17, 19-25, 27-31, 51, 53-59, and 66 are rejected under 35 U.S.C. 103(a) as being unpatentable over *Page Frame Feature for Printing Electronic Documents*;

International Business Machines Research Disclosure (hereafter referred to as IBM Research Disclosure); May 1999, pages 688-690 in view of Tsimelzon, US 6,763,388 B1 filed 8/10/1999 and Kim, US 6,330,577 B1 filed 10/15/1998.

Regarding dependent claim 5, IBM Research Disclosure does not teach modifying the font attribute of a selected portion of a web document. Kim teaches modifying the font attribute of a selected portion of a document in fig. 4-5, 8, and the abstract. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined Tsimelzon and Kim into IBM Research Disclosure to have created the claimed invention. It would have been obvious and desirable to have allowed for the changing of the font so that the user could have modified the selected portion of the web page so that it would have been more legible when outputted to the display or printer.

Regarding independent claim 13, IBM Research Disclosure teaches receiving a first web document including formatting information used to display the first web document in page 688. IBM Research Disclosure teaches receiving a request to obtain a selected portion of the document in fig. 4 and pages 689-690. IBM Research Disclosure teaches a print preview feature in page 688 which generates another representation of the document from the selected portion.

IBM research disclosure does not teach creating a second web document including the selected portion and the formatting information associated with the selected portion, in response to receiving a request, wherein the first web document and second web document are markup language documents. Tsimelzon does teach creating a second web document including the selected portion and the formatting information associated with the selected portion, in response

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to receiving a request, wherein the first web document and second web document are markup language documents in fig. 3-4, col. 5 lines 15-16, and col. 5 line 37 – col. 6 line 15.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined Tsimelzon into IBM Research Disclosure to have created the claimed invention. It would have been obvious and desirable to have used the teaching of Tsimelzon to have enhanced the print preview of IBM Research Disclosure so that the preview could have been editable by the user without affecting the original web page.

IBM Research Disclosure does not teach modifying the font attribute of a selected portion of a web document. Kim teaches modifying the font attribute of a selected portion of a document in fig. 4-5, 8, and the abstract. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined Tsimelzon and Kim into IBM Research Disclosure to have created the claimed invention. It would have been obvious and desirable to have allowed for the changing of the font so that the user could have modified the selected portion of the web page so that it would have been more legible when outputted to the display or printer.

Regarding dependent claim 14, IBM Research Disclosure does not teach modifying the font attribute of a selected portion of a web document. Kim teaches modifying the font attribute of a selected portion of a document in fig. 4-5, 8, and the abstract. Modifying the font attribute for a selected portion of text would have required font indicators to define the bounds of the text where the font attribute change was to have taken effect. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined Tsimelzon and Kim into IBM Research Disclosure to have created the claimed invention. It would have been

obvious and desirable to have allowed for the changing of the font so that the user could have modified the selected portion of the web page so that it would have been more legible when outputted to the display or printer.

Regarding dependent claim 15, IBM Research Disclosure teaches the use of both a web browser display device and a printer for outputting a web page document in page 688.

Regarding dependent claim 16, IBM Research Disclosure teaches the use of a web browser display device for outputting a web page document in page 688. Kim teaches modifying the font attribute of a selected portion of a document in fig. 4-5, 8, and the abstract. Modifying the font attribute for a selected portion of text would have required font indicators to define the bounds of the text where the font attribute change was to have taken effect. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined Tsimelzon and Kim into the IBM Research Disclosure to have created the claimed invention. It would have been obvious and desirable to have displayed the selected portion according to the font indicators because the indicators correspond to the portion of text the user had selected.

Regarding dependent claim 17, IBM Research Disclosure teaches the use of a printer for outputting a web page document in page 688. Kim teaches modifying the font attribute of a selected portion of a document in fig. 4-5, 8, and the abstract. Modifying the font attribute for a selected portion of text would have required font indicators to define the bounds of the text where the font attribute change was to have taken effect. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined Tsimelzon and Kim into the IBM Research Disclosure to have created the claimed invention. It would have been

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obvious and desirable to have printed the selected portion according to the font indicators because the indicators correspond to the portion of text the user had selected.

Regarding dependent claim 19, IBM Research Disclosure teaches the use of markup language documents on page 688. It was well known at the time of the invention that markup language documents contained formatting information in a series of tags.

Regarding dependent claim 20, IBM Research Disclosure teaches the use of markup language documents to form web pages in page 688. It was well known at the time of the invention that hypertext markup language was the most commonly used markup language used to form web pages.

Regarding dependent claim 21, IBM Research Disclosure teaches the use of markup language documents to form web pages in page 688. It was well known at the time of the invention that hypertext markup language was the most commonly used markup language used to form web pages. It was well known at the time of the invention that hypertext markup language contained formatting information in a series of tags.

Regarding dependent claim 22, IBM Research Disclosure does not teach modifying the font attribute of a selected portion of a web document. Kim teaches modifying the font attribute of a selected portion of a document in fig. 4-5, 8, and the abstract. Modifying the font attribute for a selected portion of text would have required font indicators to define the bounds of the text where the font attribute change was to have taken effect. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined Tsimelzon and Kim into IBM Research Disclosure to have created the claimed invention. It would have been obvious and desirable to have allowed for the changing of the font so that the user could have

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modified the selected portion of the web page so that it would have been more legible when outputted to the display or printer.

Regarding dependent claim 23-25, IBM Research Disclosure teaches the use of both a web browser display device and a printer for outputting a web page document in page 688. Kim teaches modifying the font attribute of a selected portion of a document in fig. 4-5, 8, and the abstract. Modifying the font attribute for a selected portion of text would have required font indicators to define the bounds of the text where the font attribute change was to have taken effect. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined Tsimelzon and Kim into the IBM Research Disclosure to have created the claimed invention. It would have been obvious and desirable to have displayed or printed the selected portion according to the font indicators because the indicators correspond to the portion of text the user had selected.

Regarding dependent claim 27, IBM Research Disclosure teaches the use of markup language documents on page 688. Kim teaches modifying the font attribute of a selected portion of a document in fig. 4-5, 8, and the abstract. Modifying the font attribute for a selected portion of text would have required font indicators to define the bounds of the text where the font attribute change was to have taken effect. It was well known at the time of the invention that markup language documents contained formatting information in a series of tags and it would have been obvious and desirable to have implemented the font indicators through the use of the tags.

Regarding dependent claim 28, IBM Research Disclosure teaches the use of markup language documents to form web pages in page 688. It was well known at the time of the

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invention that hypertext markup language was the most commonly used markup language used to form web pages.

Regarding dependent claim 29, IBM Research Disclosure teaches the use of markup language documents to form web pages in page 688. It was well known at the time of the invention that hypertext markup language was the most commonly used markup language used to form web pages. Kim teaches modifying the font attribute of a selected portion of a document in fig. 4-5, 8, and the abstract. Modifying the font attribute for a selected portion of text would have required font indicators to define the bounds of the text where the font attribute change was to have taken effect. It was well known at the time of the invention that hypertext markup language contained formatting information in a series of tags and it would have been obvious and desirable to have implemented the font indicators through the use of the tags.

Regarding dependent claim 30, IBM Research Disclosure does not teach modifying the font attribute of a selected portion of a web document. Kim teaches modifying the font attribute of a selected portion of a document in fig. 4-5, 8, and the abstract. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined Tsimelzon and Kim into IBM Research Disclosure to have created the claimed invention. It would have been obvious and desirable to have allowed for the changing of the font so that the user could have modified the selected portion of the web page so that it would have been more legible when outputted to the display or printer.

Regarding dependent claim 31, IBM Research Disclosure does not teach modifying the font attribute of a selected portion of a web document. Kim teaches modifying the font attribute of a selected portion of a document in fig. 4-5, 8, and the abstract. It would have been obvious to

one of ordinary skill in the art at the time the invention was made to have combined Tsimelzon and Kim into IBM Research Disclosure to have created the claimed invention. It would have been obvious and desirable to have allowed for the changing of the font so that the user could have modified the selected portion of the web page so that it would have been more legible when outputted to the display or printer.

Regarding dependent claim 51, IBM Research Disclosure teaches receiving a first web document including formatting information used to display the first web document in page 688. IBM Research Disclosure teaches receiving a request to obtain a selected portion of the document in fig. 4 and pages 689-690. IBM Research Disclosure teaches a print preview feature in page 688 which generates another representation of the document from the selected portion.

IBM research disclosure does not teach creating a second web document including the selected portion and the formatting information associated with the selected portion, in response to receiving a request, wherein the first web document and second web document are markup language documents. IBM Research Disclosure does not teach creating a third web document from the second web document. Tsimelzon does teach creating a web document including the selected portion and the formatting information associated with the selected portion, in response to receiving a request, wherein the first web document and second web document are markup language documents in fig. 3-4, col. 5 lines 15-16, and col. 5 line 37 – col. 6 line 15.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined Tsimelzon into IBM Research Disclosure to have created the claimed invention. It would have been obvious and desirable to have used the teaching of Tsimelzon to have enhanced the print preview of IBM Research Disclosure so that the preview

could have been editable by the user without affecting the original web page. It would have been obvious and desirable to have used the document creation method of Tsimelzon recursively to have produced a third document so that changes could be made to a portion of the second document without altering the second document.

IBM Research Disclosure does not teach modifying the font attribute of a selected portion of a web document. Kim teaches modifying the font attribute of a selected portion of a document in fig. 4-5, 8, and the abstract. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined Tsimelzon and Kim into IBM Research Disclosure to have created the claimed invention. It would have been obvious and desirable to have allowed for the changing of the font so that the user could have modified the selected portion of the web page so that it would have been more legible when outputted to the display or printer.

Regarding independent claim 53, IBM Research Disclosure teaches receiving a first web document including formatting information used to display the first web document in page 688. IBM Research Disclosure teaches receiving a request to obtain a selected portion of the document in fig. 4 and pages 689-690. IBM Research Disclosure teaches a print preview feature in page 688 which generates another representation of the document from the selected portion.

IBM research disclosure does not teach creating a second web document including the selected portion and the formatting information associated with the selected portion, in response to receiving a request, wherein the first web document and second web document are markup language documents. Tsimelzon does teach creating a second web document including the selected portion and the formatting information associated with the selected portion, in response

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to receiving a request, wherein the first web document and second web document are markup language documents in fig. 3-4, col. 5 lines 15-16, and col. 5 line 37 – col. 6 line 15.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined Tsimelzon into IBM Research Disclosure to have created the claimed invention. It would have been obvious and desirable to have used the teaching of Tsimelzon to have enhanced the print preview of IBM Research Disclosure so that the preview could have been editable by the user without affecting the original web page.

IBM Research Disclosure does not teach modifying the font attribute of a selected portion of a web document. Kim teaches modifying the font attribute of a selected portion of a document in fig. 4-5, 8, and the abstract. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined Tsimelzon and Kim into IBM Research Disclosure to have created the claimed invention. It would have been obvious and desirable to have allowed for the changing of the font so that the user could have modified the selected portion of the web page so that it would have been more legible when outputted to the display or printer.

Regarding dependent claim 54, IBM Research Disclosure does not teach modifying the font attribute of a selected portion of a web document. Kim teaches modifying the font attribute of a selected portion of a document by using virtual font indicators before and after the text within the selected portion in fig. 4-5, 8, and the abstract. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined Tsimelzon and Kim into IBM Research Disclosure to have created the claimed invention. It would have been obvious and desirable to have allowed for the changing of the font so that the user could have

modified the selected portion of the web page so that it would have been more legible when outputted to the display or printer.

Regarding dependent claims 55-56 and 58-59, IBM Research Disclosure teaches the use of both a web browser display device and a printer for outputting a web page document in page 688. Kim teaches modifying the font attribute of a selected portion of a document in fig. 4-5, 8, and the abstract. Modifying the font attribute for a selected portion of text would have required font indicators to define the bounds of the text where the font attribute change was to have taken effect. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined Tsimelzon and Kim into the IBM Research Disclosure to have created the claimed invention. It would have been obvious and desirable to have displayed or printed the selected portion according to the font indicators because the indicators correspond to the portion of text the user had selected.

Regarding dependent claim 57, IBM Research Disclosure does not teach modifying the font attribute of a selected portion of a web document. Kim teaches modifying the font attribute of a selected portion of a document in fig. 4-5, 8, and the abstract. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined Tsimelzon and Kim into IBM Research Disclosure to have created the claimed invention. It would have been obvious and desirable to have allowed for the changing of the font so that the user could have modified the selected portion of the web page so that it would have been more legible when outputted to the display or printer.

Regarding independent claim 66, IBM Research Disclosure teaches receiving a first web document including formatting information used to display the first web document in page

688. IBM Research Disclosure teaches receiving a request to obtain a selected portion of the document in fig. 4 and pages 689-690. IBM Research Disclosure teaches a print preview feature in page 688 which generates another representation of the document from the selected portion.

IBM research disclosure does not teach creating a second web document including the selected portion and the formatting information associated with the selected portion, in response to receiving a request, wherein the first web document and second web document are markup language documents. Tsimelzon does teach creating a second web document including the selected portion and the formatting information associated with the selected portion, in response to receiving a request, wherein the first web document and second web document are markup language documents in fig. 3-4, col. 5 lines 15-16, and col. 5 line 37 – col. 6 line 15.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined Tsimelzon into IBM Research Disclosure to have created the claimed invention. It would have been obvious and desirable to have used the teaching of Tsimelzon to have enhanced the print preview of IBM Research Disclosure so that the preview could have been editable by the user without affecting the original web page.

IBM Research Disclosure does not teach modifying the font attribute of a selected portion of a web document. Kim teaches modifying the font attribute of a selected portion of a document in fig. 4-5, 8, and the abstract. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined Tsimelzon and Kim into IBM Research Disclosure to have created the claimed invention. It would have been obvious and desirable to have allowed for the changing of the font so that the user could have modified the

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selected portion of the web page so that it would have been more legible when outputted to the display or printer.

6. Claims 7, 32-37, 39-46, 60-63, and 67 are rejected under 35 U.S.C. 103(a) as being unpatentable over *Page Frame Feature for Printing Electronic Documents*; International Business Machines Research Disclosure (hereafter referred to as IBM Research Disclosure); May 1999, pages 688-690 in view of Tsimelzon, US 6,763,388 B1 filed 8/10/1999 and Michelman et al. (hereafter referred to as Michelman), US 6,487,567 B1, continuation filed 03/25/1997.

Regarding dependent claim 7, IBM Research Disclosure teaches receiving a first web document including formatting information used to display the first web document in page 688. IBM Research Disclosure teaches receiving a request to obtain a selected portion of the document in fig. 4 and pages 689-690. IBM Research Disclosure teaches a print preview feature in page 688 which generates another representation of the document from the selected portion.

IBM research disclosure does not teach creating a second web document including the selected portion and the formatting information associated with the selected portion, in response to receiving a request, wherein the first web document and second web document are markup language documents. Tsimelzon does teach creating a second web document including the selected portion and the formatting information associated with the selected portion, in response to receiving a request, wherein the first web document and second web document are markup language documents in fig. 3-4, col. 5 lines 15-16, and col. 5 line 37 – col. 6 line 15.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined Tsimelzon into IBM Research Disclosure to have created the claimed invention. It would have been obvious and desirable to have used the teaching of Tsimelzon to have enhanced the print preview of IBM Research Disclosure so that the preview could have been editable by the user without affecting the original web page.

IBM Research Disclosure does not teach inserting additional page breaks indicators into a web document. Michelman does teach manipulating page breaks and page break indicators in a document in the abstract. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the IBM Research Disclosure so that the page margins and page breaks indicators could have been modified after the initial frame selection setting up the page breaks for the initial page. It would have been obvious and desirable to have implemented this combination so that the user could have had further control in preparing the display of the selected portion of the document for output to either a display or a printer.

Regarding independent claim 32, IBM Research Disclosure does not teach inserting additional page breaks indicators into the second web document. Michelman does teach manipulating page breaks and page break indicators in a document in the abstract. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the IBM Research Disclosure so that the page margins and page breaks indicators could have been modified after the initial frame selection setting up the page breaks for the initial page. It would have been obvious and desirable to have implemented this combination so that the user could have had further control in preparing the display of the selected portion of the document for output to either a display or a printer.

Regarding dependent claims 33-34, IBM Research Disclosure does not teach inserting additional page breaks indicators into the second web document. Michelman does teach manipulating page breaks and page break indicators in a document in the abstract. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the IBM Research Disclosure so that the page margins and page breaks indicators could have been modified after the initial frame selection setting up the page breaks for the initial page. It would have been obvious and desirable to have implemented this combination so that the user could have had further control in preparing the display of the selected portion of the document for output to either a display or a printer.

Regarding dependent claim 35-37, IBM Research Disclosure teaches the use of both a web browser display device and a printer for outputting a web page document in page 688.

Regarding dependent claim 39, IBM Research Disclosure teaches the use of markup language documents on page 688. It was well known at the time of the invention that markup language documents contained formatting information in a series of tags. It would have been obvious to have encoded the page break indicator formatting information into tags so that page break could have been implemented in the markup language.

Regarding dependent claim 40, IBM Research Disclosure teaches the use of markup language documents to form web pages in page 688. It was well known at the time of the invention that hypertext markup language was the most commonly used markup language used to form web pages.

Regarding dependent claim 41, IBM Research Disclosure teaches the use of markup language documents to form web pages in page 688. It was well known at the time of the

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invention that hypertext markup language was the most commonly used markup language used to form web pages. It was well known at the time of the invention that hypertext markup language contained formatting information in a series of tags. It would have been obvious to have encoded the page break indicator formatting information into tags so that page break could have been implemented in the markup language.

Regarding dependent claims 42-44, IBM Research Disclosure does not teach inserting additional page breaks indicators into a web document. Michelman does teach manipulating page breaks and page break indicators in a document in the abstract. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the IBM Research Disclosure so that the page margins and page breaks indicators could have been modified after the initial frame selection setting up the page breaks for the initial page. It would have been obvious and desirable to have implemented this combination so that the user could have had further control in preparing the display of the selected portion of the document for output to either a display or a printer.

Regarding dependent claim 45, IBM Research Disclosure teaches the use of a printer for outputting a web page document in page 688. Printers inherently use print drivers to obtain the information to output.

Regarding dependent claim 46, IBM Research Disclosure does not teach inserting additional page breaks indicators into a web document. Michelman does teach manipulating page breaks and page break indicators in a document in the abstract. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the IBM Research Disclosure so that the page margins and page breaks indicators could have been

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modified after the initial frame selection setting up the page breaks for the initial page. It would have been obvious and desirable to have implemented this combination so that the user could have had further control in preparing the display of the selected portion of the document for output to either a display or a printer.

Regarding independent claim 60, IBM Research Disclosure teaches receiving a first web document including formatting information used to display the first web document in page 688. IBM Research Disclosure teaches receiving a request to obtain a selected portion of the document in fig. 4 and pages 689-690. IBM Research Disclosure teaches a print preview feature in page 688 which generates another representation of the document from the selected portion.

IBM research disclosure does not teach creating a second web document including the selected portion and the formatting information associated with the selected portion, in response to receiving a request, wherein the first web document and second web document are markup language documents. Tsimelzon does teach creating a second web document including the selected portion and the formatting information associated with the selected portion, in response to receiving a request, wherein the first web document and second web document are markup language documents in fig. 3-4, col. 5 lines 15-16, and col. 5 line 37 – col. 6 line 15.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined Tsimelzon into IBM Research Disclosure to have created the claimed invention. It would have been obvious and desirable to have used the teaching of Tsimelzon to have enhanced the print preview of IBM Research Disclosure so that the preview could have been editable by the user without affecting the original web page.

IBM Research Disclosure does not teach inserting additional page breaks indicators into the second web document. Michelman does teach manipulating page breaks and page break indicators in a document in the abstract. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the IBM Research Disclosure so that the page margins and page breaks indicators could have been modified after the initial frame selection setting up the page breaks for the initial page. It would have been obvious and desirable to have implemented this combination so that the user could have had further control in preparing the display of the selected portion of the document for output to either a display or a printer.

Regarding dependent claims 61-62, IBM Research Disclosure does not teach inserting additional page breaks indicators into a web document. Michelman does teach manipulating page breaks and page break indicators in a document in the abstract. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the IBM Research Disclosure so that the page margins and page breaks indicators could have been modified after the initial frame selection setting up the page breaks for the initial page. It would have been obvious and desirable to have implemented this combination so that the user could have had further control in preparing the display of the selected portion of the document for output to either a display or a printer.

Regarding dependent claim 63, IBM Research Disclosure teaches the use of both a web browser display device and a printer for outputting a web page document in page 688.

Regarding independent claim 67, IBM Research Disclosure teaches receiving a first web document including formatting information used to display the first web document in page

688. IBM Research Disclosure teaches receiving a request to obtain a selected portion of the document in fig. 4 and pages 689-690. IBM Research Disclosure teaches a print preview feature in page 688 which generates another representation of the document from the selected portion.

IBM research disclosure does not teach creating a second web document including the selected portion and the formatting information associated with the selected portion, in response to receiving a request, wherein the first web document and second web document are markup language documents. Tsimelzon does teach creating a second web document including the selected portion and the formatting information associated with the selected portion, in response to receiving a request, wherein the first web document and second web document are markup language documents in fig. 3-4, col. 5 lines 15-16, and col. 5 line 37 – col. 6 line 15.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined Tsimelzon into IBM Research Disclosure to have created the claimed invention. It would have been obvious and desirable to have used the teaching of Tsimelzon to have enhanced the print preview of IBM Research Disclosure so that the preview could have been editable by the user without affecting the original web page.

IBM Research Disclosure does not teach inserting additional page breaks indicators into a web document. Michelman does teach manipulating page breaks and page break indicators in a document in the abstract. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the IBM Research Disclosure so that the page margins and page breaks indicators could have been modified after the initial frame selection setting up the page breaks for the initial page. It would have been obvious and desirable to have

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implemented this combination so that the user could have had further control in preparing the display of the selected portion of the document for output to either a display or a printer.

7. Claims 6, 47, 64, and 68-70 are rejected under 35 U.S.C. 103(a) as being unpatentable over *Page Frame Feature for Printing Electronic Documents*; International Business Machines Research Disclosure (hereafter referred to as IBM Research Disclosure); May 1999, pages 688-690 in view of Tsimelzon, US 6,763,388 B1 filed 8/10/1999, Kim, US 6,330,577 B1 filed 10/15/1998, and Michelman et al. (hereafter referred to as Michelman), US 6,487,567 B1, continuation filed 03/25/1997.

Regarding dependent claim 6, IBM Research Disclosure does not teach inserting additional page breaks indicators into a web document. Michelman does teach manipulating page breaks and page break indicators in a document in the abstract. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the IBM Research Disclosure so that the page margins and page breaks indicators could have been modified after the initial frame selection setting up the page breaks for the initial page. It would have been obvious and desirable to have implemented this combination so that the user could have had further control in preparing the display of the selected portion of the document for output to either a display or a printer.

Regarding independent claim 47, IBM Research Disclosure does not teach modifying the font attribute of a selected portion of a web document. Kim teaches modifying the font attribute of a selected portion of a document in fig. 4-5, 8, and the abstract. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined

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Tsimelzon and Kim into IBM Research Disclosure to have created the claimed invention. It would have been obvious and desirable to have allowed for the changing of the font so that the user could have modified the selected portion of the web page so that it would have been more legible when outputted to the display or printer.

IBM Research Disclosure does not teach inserting additional page breaks indicators into a web document. Michelman does teach manipulating page breaks and page break indicators in a document in the abstract. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the IBM Research Disclosure so that the page margins and page breaks indicators could have been modified after the initial frame selection setting up the page breaks for the initial page. It would have been obvious and desirable to have implemented this combination so that the user could have had further control in preparing the display of the selected portion of the document for output to either a display or a printer.

Regarding independent claim 64, IBM Research Disclosure teaches receiving a first web document including formatting information used to display the first web document in page 688. IBM Research Disclosure teaches receiving a request to obtain a selected portion of the document in fig. 4 and pages 689-690. IBM Research Disclosure teaches a print preview feature in page 688 which generates another representation of the document from the selected portion.

IBM research disclosure does not teach creating a second web document including the selected portion and the formatting information associated with the selected portion, in response to receiving a request, wherein the first web document and second web document are markup language documents. Tsimelzon does teach creating a second web document including the selected portion and the formatting information associated with the selected portion, in response

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to receiving a request, wherein the first web document and second web document are markup language documents in fig. 3-4, col. 5 lines 15-16, and col. 5 line 37 – col. 6 line 15.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined Tsimelzon into IBM Research Disclosure to have created the claimed invention. It would have been obvious and desirable to have used the teaching of Tsimelzon to have enhanced the print preview of IBM Research Disclosure so that the preview could have been editable by the user without affecting the original web page.

IBM Research Disclosure does not teach inserting additional page breaks indicators into a web document. Michelman does teach manipulating page breaks and page break indicators in a document in the abstract. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the IBM Research Disclosure so that the page margins and page breaks indicators could have been modified after the initial frame selection setting up the page breaks for the initial page. It would have been obvious and desirable to have implemented this combination so that the user could have had further control in preparing the display of the selected portion of the document for output to either a display or a printer.

Regarding independent claim 68, IBM Research Disclosure teaches receiving a first web document including formatting information used to display the first web document in page 688. IBM Research Disclosure teaches receiving a request to obtain a selected portion of the document in fig. 4 and pages 689-690. IBM Research Disclosure teaches a print preview feature in page 688 which generates another representation of the document from the selected portion.

IBM research disclosure does not teach creating a second web document including the selected portion and the formatting information associated with the selected portion, in response

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to receiving a request, wherein the first web document and second web document are markup language documents. Tsimelzon does teach creating a second web document including the selected portion and the formatting information associated with the selected portion, in response to receiving a request, wherein the first web document and second web document are markup language documents in fig. 3-4, col. 5 lines 15-16, and col. 5 line 37 – col. 6 line 15.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined Tsimelzon into IBM Research Disclosure to have created the claimed invention. It would have been obvious and desirable to have used the teaching of Tsimelzon to have enhanced the print preview of IBM Research Disclosure so that the preview could have been editable by the user without affecting the original web page.

IBM Research Disclosure does not teach modifying the font attribute of a selected portion of a web document. Kim teaches modifying the font attribute of a selected portion of a document in fig. 4-5, 8, and the abstract. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined Tsimelzon and Kim into IBM Research Disclosure to have created the claimed invention. It would have been obvious and desirable to have allowed for the changing of the font so that the user could have modified the selected portion of the web page so that it would have been more legible when outputted to the display or printer.

IBM Research Disclosure does not teach inserting additional page breaks indicators into a web document. Michelman does teach manipulating page breaks and page break indicators in a document in the abstract. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the IBM Research Disclosure so that the page

margins and page breaks indicators could have been modified after the initial frame selection setting up the page breaks for the initial page. It would have been obvious and desirable to have implemented this combination so that the user could have had further control in preparing the display of the selected portion of the document for output to either a display or a printer.

Regarding independent claim 69, IBM Research Disclosure teaches receiving a first web document including formatting information used to display the first web document in page 688. IBM Research Disclosure teaches receiving a request to obtain a selected portion of the document in fig. 4 and pages 689-690. IBM Research Disclosure teaches a print preview feature in page 688 which generates another representation of the document from the selected portion.

IBM research disclosure does not teach creating a second web document including the selected portion and the formatting information associated with the selected portion, in response to receiving a request, wherein the first web document and second web document are markup language documents. Tsimelzon does teach creating a second web document including the selected portion and the formatting information associated with the selected portion, in response to receiving a request, wherein the first web document and second web document are markup language documents in fig. 3-4, col. 5 lines 15-16, and col. 5 line 37 – col. 6 line 15.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined Tsimelzon into IBM Research Disclosure to have created the claimed invention. It would have been obvious and desirable to have used the teaching of Tsimelzon to have enhanced the print preview of IBM Research Disclosure so that the preview could have been editable by the user without affecting the original web page.

IBM Research Disclosure does not teach modifying the font attribute of a selected portion of a web document. Kim teaches modifying the font attribute of a selected portion of a document in fig. 4-5, 8, and the abstract. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined Tsimelzon and Kim into IBM Research Disclosure to have created the claimed invention. It would have been obvious and desirable to have allowed for the changing of the font so that the user could have modified the selected portion of the web page so that it would have been more legible when outputted to the display or printer.

IBM Research Disclosure does not teach inserting additional page breaks indicators into a web document. Michelman does teach manipulating page breaks and page break indicators in a document in the abstract. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the IBM Research Disclosure so that the page margins and page breaks indicators could have been modified after the initial frame selection setting up the page breaks for the initial page. It would have been obvious and desirable to have implemented this combination so that the user could have had further control in preparing the display of the selected portion of the document for output to either a display or a printer.

Regarding independent claim 70, IBM Research Disclosure teaches receiving a first web document including formatting information used to display the first web document in page 688. IBM Research Disclosure teaches receiving a request to obtain a selected portion of the document in fig. 4 and pages 689-690. IBM Research Disclosure teaches a print preview feature in page 688 which generates another representation of the document from the selected portion.

IBM research disclosure does not teach creating a second web document including the selected portion and the formatting information associated with the selected portion, in response to receiving a request, wherein the first web document and second web document are markup language documents. Tsimelzon does teach creating a second web document including the selected portion and the formatting information associated with the selected portion, in response to receiving a request, wherein the first web document and second web document are markup language documents in fig. 3-4, col. 5 lines 15-16, and col. 5 line 37 – col. 6 line 15.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined Tsimelzon into IBM Research Disclosure to have created the claimed invention. It would have been obvious and desirable to have used the teaching of Tsimelzon to have enhanced the print preview of IBM Research Disclosure so that the preview could have been editable by the user without affecting the original web page.

IBM Research Disclosure does not teach modifying the font attribute of a selected portion of a web document. Kim teaches modifying the font attribute of a selected portion of a document in fig. 4-5, 8, and the abstract. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined Tsimelzon and Kim into IBM Research Disclosure to have created the claimed invention. It would have been obvious and desirable to have allowed for the changing of the font so that the user could have modified the selected portion of the web page so that it would have been more legible when outputted to the display or printer.

IBM Research Disclosure does not teach inserting additional page breaks indicators into a web document. Michelman does teach manipulating page breaks and page break indicators in a

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document in the abstract. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the IBM Research Disclosure so that the page margins and page breaks indicators could have been modified after the initial frame selection setting up the page breaks for the initial page. It would have been obvious and desirable to have implemented this combination so that the user could have had further control in preparing the display of the selected portion of the document for output to either a display or a printer.

Response to Arguments

8. Applicant's arguments with respect to claims 1-70 have been considered but are moot in view of the new ground(s) of rejection. The Examiner has additionally introduced the prior art of Tsimelzon which teaches creating a separate Web markup language document from a portion of a larger original Web markup language document. The newly created "short web page" has a unique URL and is individually editable by the user.

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Kaghazian, US 6,563,913 B1 filed 8/21/2000 discloses selecting one or more portions from an electronic document and generating a new document that comprises the selected portions. Lenk et al., US 6,366,923 B1 filed 3/23/1998 discloses clipping data from Web pages and then producing a document from the clipped data wherein the clipped data may be edited. Britton et al., US 6,535,896 B2 filed 1/29/1999 discloses tools to tailor HTML-based Web page content for display within various client devices.

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10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Peter J Smith whose telephone number is 703-305-5931 (571-272-4101 after 10/20/2004). The examiner can normally be reached on Mondays-Fridays 7:00am-3:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph H Feild can be reached on 703-305-9792 (571-272-4090 after 10/20/2004). The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

PJS

September 21, 2004


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